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Election
11-5-93
M.F.B.

PATENT
Customer No. 22,852
Attorney Docket No. 5725.1014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Vincent DE LAFORCADE) Group Art Unit: 3754
)
Application No.: 10/058,401) Examiner: K. Bomberg
)
Filed: January 30, 2002)
)
For: DEVICE FOR DISPENSING)
PRODUCT)

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TECHNOLOGY CENTER R3700

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

The following remarks are responsive to the Office Action dated October 3, 2003.

In the Office Action, the Examiner required restriction under 35 U.S.C. § 121
between:

Group I: claims 1-192; and

Group II: claims 193-292.

The Examiner asserted that the claim groups are related as a "combination and subcombination." Office Action at 2. The Examiner further asserted that "the combination as claimed does not require the particulars of the subcombination as claimed because particulars of the subcombination claims . . . have been omitted from various of the independent combination claims." Id.

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Applicant respectfully disagrees with the restriction requirement and requests that the Examiner withdraw it for the following reasons. As described in M.P.E.P. § 806.05(c), in order to establish a proper combination-subcombination restriction requirement, the Office has the burden of demonstrating "two-way distinctness." Applicant respectfully submits that the Office Action has not met that burden.

For example, Applicant notes that independent claims 1, 34, 97, and 130 of Group I recite a substantial amount of the subject matter of independent claims 227, 244, 193, and 210, respectively, of Group II. More importantly, contrary to the Examiner's assertions, claims 130 and 161 of Group I include a recitation relating to dispensing regardless of orientation; claim 34 of Group I includes a recitation concerning non-elastically deformable material; and claims 1 and 97 of Group I include a recitation concerning pressure in the pouch. Since the Office Action has not satisfied the burden of showing two-way distinctness, Applicant respectfully submits that the combination-subcombination restriction requirement should be withdrawn.

Applicant also respectfully submits that the restriction requirement should be withdrawn because it would not constitute an undue burden to search all of the subject matter of Groups I and II together. "If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803 (emphasis added). Applicant submits that the searches required to properly examine the claims of Groups I and II would necessarily overlap one another. Since there is a common search required to search the claims of Groups I and II, it would not be unduly burdensome to examine the claims of Groups I and II together.

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For at least the reasons set forth above, Applicant respectfully traverses the restriction requirement and respectfully requests that it be withdrawn. If the Examiner declines to withdraw the restriction requirement, Applicant respectfully requests that the Examiner acknowledge this traversal and indicate the finality of the restriction requirement so that Applicant will be able to submit a Petition under 37 C.F.R. § 1.144 requesting review of this requirement. To be fully responsive to the Examiner's requirement to elect one of the claim groupings, Applicant provisionally elects Group I, claims 1-192, with traverse.

The Office Action also requires an election of species between the following asserted species:

1. Figs. 1-5;
2. Figs. 6A-6C; and
3. Fig. 7.

Applicant provisionally elects to prosecute the species of Figs. 1-5. At least the following claims are readable on the elected species: 1-17, 19-50, 52-80, 82-113, 115-146, 148-176, and 178-292.

Applicant notes that the Office Action contains a number of statements reflecting assertions relating to the claims. Regardless of whether any such statements are addressed herein, Applicant does not necessarily agree with any statement or assertion in the Office Action.

If the Examiner believes that a telephone conversation would advance prosecution of this application, the Examiner is invited to call Applicant's undersigned attorney (571-203-2774).

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 3, 2003

By: 
Anthony M. Gutowski
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